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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/731,173

12/08/2003

Shawn W. O'Driscoll

ACM 340US

5061

23581

7590

09/12/2006

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EXAMINER

STOKES, CANDICE CAPRI

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 09/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/731,173

Applicant(s)

O'DRISCOLL ET AL.

Examiner

Candice C. Stokes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,9-14 and 31-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3,9-14 and 31-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1) Claims 3,12-14 and 31-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henniges et al (USPN 6,592,578). Henniges et al teach a system and method for installing plates for general bone repair. Henniges et al disclose “it is an additional feature of the present invention to color code the plates 10 for easy identification during a surgical procedure. The plates 10 can come in several different sizes and shapes depending on the specific application. By manufacturing the plates 10 with a unique color associated with each unique shape and size, confusion will be minimized and time will be saved. The color-coding will allow a doctor or nurse to identify and request the specific plate 10 and to better locate and implant screws and plates in vivo” (col. 6, lines 45-55). As to the portion of claim 34, “being configured to be secured...”, it is noted that it has been held that a recitation that an element is “configured to” perform a function is not a positive limitation and only requires the ability to so perform. It does not constitute a limitation in any patentable sense. Furthermore, with regard to the arguments about the functional language, it is noted that the law of anticipation does not require that the reference “teach” what the application teaches, but rather it is only that the claims under attack “read on” something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). In addition, the manner in which a device is intended to be employed does not

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differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham, 2 USPQ2d 1647 (1987)*. As to Claim 12, plates 10 include a curve bone-facing surface configured to match the curved contour of the distinct bone region to which each plate is configured to be secured. Regarding Claim 13, the only difference between invention claimed in claim 34 and claim 13 is the printed matter, which in no way depends on the set, and the set does not depend on the printed matter. Therefore, the same rejection applied to claim 34 may also be applied to claim 13. As to Claims 31 and 32, the term “configured” merely requires the plates be capable of being secured to either corresponding or non-corresponding bones. Therefore, these limitations are met by the Henniges et al reference as well.

Henniges et al teach the claimed invention except for the distinct color indicating a left or right half of the skeleton. However, the Henniges et al reference does teach that the association of color with each plate makes it easier to identify and locate in the body. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a color coded method for identifying the each plate as taught by Henniges et al in order to minimize confusion during a surgical procedure.

Regarding Claim 33, it would have been an obvious matter of design choice to manufacture the bone plates in any color, since applicant has not disclosed that having the plates blue and green solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with any color.

To claim 35, it would have been an obvious matter of design choice to make the pair of bone plates with a shape having corresponding mirror images of one another or any shape, since

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such a modification would have involved a mere change in the shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art.

2) Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henniges et al in view of Streli (USPN 4,565,193). Henniges et al discloses the claimed invention except for one of the distinct bone region including one of the humerus bone and the proximal region and at least one of the bone plates includes at least one prong. Streli teaches a pronged plate “for use on the right or left half of the body”. Streli further teaches “using the pronged plate 1 in the region of the lower arm, the ulna and the radius” (col. 3, lines 40-41). It would have been obvious to one having ordinary skills in the art to incorporate the pronged plate used on the ulna into as taught by Streli into the set disclosed by Henniges et al in order to provide a means for better securing the plate the bone to better promote healing.

3) Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henniges et al in view of Weaver et al (USPN 6,623,486). Henniges et al disclose the claimed invention except for the bone plate have a first portion configured to be secured adjacent an end of a long bone and a second portion configured to be secured toward or one the shaft of the long bone and wherein the first portion is thinner than the second portion. Weaver et al shows in Fig. 8 that the first portion is generally thinner that the second portion of the plate. It would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the thinner first portion of the bone plate as taught by Weaver et al into the invention disclosed by Henniges et al in order to provide a bone plate which is better contoured to fit specific regions of bone and is better secured to the bone.

Response to Arguments

Applicant's arguments filed 06/26/06 have been fully considered but they are not persuasive. Applicants submit "Henniges teaches that each unique plate should have its own unique color to allow the various unique plates to be distinguished from one another, to minimize confusion and save time. However, claim 34 recites a pair of plates including the same color and having different shapes" (see Response to Office Action page 8, lines 1-4). The Office maintains that the present invention is unpatentable over the Henniges reference because the Henniges reference teaches that color-coding bone plates for the purpose of identification. Specific colors used and specific uses of the identification as provided in the present amendment, do not render the claims patentable over the prior art of record. Therefore, claims 3,9-14, and 31-33 remain rejected. Claims 34-35 stand newly rejected.

Also, Applicant's incorrectly state that claims 1,3,4,9-14, and 31-33 are pending. Please note that the pending claims are 3,9-14, and 31-35.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Candice C. Stokes whose telephone number is (571) 272-4714. The examiner can normally be reached on 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Candice C. Stokes


CRIS L. RODRIGUEZ
PRIMARY EXAMINER